



TFW 28/2

PATENT
Customer No. 22,852
Attorney Docket No. 05793.3015-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Group Art Unit: 3693
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Peter A. SCHNALL) Examiner: Richard C. Weisberger
)
Application No.: 09/783,980)
) Confirmation No.: 2812
Filed: February 16, 2001)
)
For: METHOD AND APPARATUS FOR)
MONITORING GUARANTEED)
LOANS AND NOTIFYING)
GUARANTORS)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO REQUIREMENT FOR INFORMATION UNDER 37 C.F.R. § 1.105

On December 29, 2006, the Examiner issued a Requirement for Information under 37 C.F.R. § 1.105, requesting certain information from Applicant. A response to that paper is due on February 28, 2007.

Applicant objects to the requirement for information because it is improper since the Examiner has previously issued an Office Action on the merits¹. See 37 C.F.R. § 1.105; M.P.E.P. § 704.11(b). In relevant part, M.P.E.P. § 704.11(b) states,

A requirement for information made after the first action on the merits may be appropriate when the application file justifies asking the applicant if he or she has

¹ Non-Final Office Action dated February 14, 2006.

information that would be relevant to the patentability determination. It is rarely appropriate to require information because of a lack of relevant prior art after the first action on the merits.

Here, the Examiner has provided no justification based on the application file for asking Applicant if he has information that would be relevant to the patentability determination. Applicant respectfully submits that the Requirement for Information is not reasonably necessary for examination of this application. In particular, the requirement is based on "Supervisor of Banks: Proper Conduct of Banking Business" (*Proper Conduct*), a document cited by the Examiner² in the Office Action mailed February 14, 2006. The information requested is not reasonably necessary for examination because the Examiner has not demonstrated that *Proper Conduct* was in fact published before the priority date for this application. Therefore, the Examiner has not demonstrated that *Proper Conduct* is pertinent prior art under 35 U.S.C. § 102 or 35 U.S.C. § 103.

For example, in the February 14, 2006 Office Action, the Examiner alleged that *Proper Conduct* "may have been published after the effective filing data of this application." In such case, "the examiner takes official notice the similar banking codes of conduct have existed prior to the effective filing date of this application" (Office Action at p. 3). In the Reply filed on June 14, 2006, Applicant traversed the Examiner's taking of Official Notice and further submitted that the Examiner had not demonstrated that the reference was in fact published before the priority date for this application. In response to Applicant's Reply, the Examiner issued a Restriction Requirement on September 8,

² See http://www.bankisrael.gov.il/deptdata/pikuah/nihul_takin/eng/453_et.pdf (form PTO-892 included with Non-Final Office Action on the merits dated February 14, 2006).

2006. Applicant timely responded to the Restriction Requirement on October 10, 2006.

Thus, Examiner has not yet established that *Proper Conduct* qualifies as prior art against the present application. Accordingly, Applicant respectfully submits that the Examiner's Request for Information based on this reference is not reasonably necessary for examination of this application.

Applicant also objects to the requirement because it directs Applicant to answer, "the degrees to which the steps/contents/procedures therein are known to those skilled in the art of banking" and "[i]f the practice is known, please indicate to what degree, if any, these steps/contents/procedures have been automated" (Request at p. 2). Such inquiries are improper in view of the guidelines set forth by M.P.E.P. § 714.14. In relevant part, M.P.E.P. § 714.14 states,

A requirement for information under 37 CFR 1.105 should be narrowly specified and limited in scope. It is a significant burden on both the applicant and the Office since the applicant must collect and submit the required information and the examiner must consider all the information that is submitted. A requirement for information is only warranted where the benefit from the information exceeds the burden in obtaining information.

Here, determining on a paragraph by paragraph basis what was known to those skilled in the art with regard to *Proper Conduct* is clearly more burdensome than any benefit of obtaining any information. Nonetheless, in response to the Examiner's request, to the best of Applicant's knowledge, Applicant does not know what the author of "Proper Conduct" considered in what the Examiner alleges is prior art as of the date of the reference and such information is not readily accessible. See 37 C.F.R. § 1.105(a)(4).

It is not believed that any additional fees are due but if necessary, please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 28, 2007

By: 

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Reg. No. 46,508